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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,121	12/30/2003	Jeffrey O. Saunders	VPI/02-05 US	3285
27916	7590	09/12/2006	EXAMINER	
VERTEX PHARMACEUTICALS INC. 130 WAVERLY STREET CAMBRIDGE, MA 02139-4242			BARKER, MICHAEL P	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/749,121	Applicant(s) SAUNDERS ET AL.	
	Examiner Michael P. Barker	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/7/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 25-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 10-24 is/are rejected.
- 7) ☒ Claim(s) 6-9 and 25-74 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant amended **Claims 1, 3, 4, 5, 10, 12, and 14**. Applicant canceled **Claim 2**. **Claims 6-9 and 25-74** are withdrawn from consideration. Therefore, **Claims 1, 3-5, and 10-24** are pending in this Application. **Claims 1, 3-5, and 10-24** are rejected.

Examiner's Comment

The search on which the rejections of the February 6, 2006 Office Action was based was incomplete. Not included in the search were those compounds covered by Group I of formula (I-A). As this is the Examiner's mistake, this Office Action is non-final, as the rejections which follow could have been made in the previous Office Action.

Response to August 7, 2006 Remarks Document

Applicant's amendments to **Claims 1, 3, 4, 5, 10, 12, and 14** are acknowledged. These amendments overcome the rejections put forth in the February 6, 2006 Office Action. Those rejections are withdrawn.

Applicant's cancellation of **Claim 2** is acknowledged. Applicant states the withdrawn **Claims 6-9 and 25-74** are canceled. However, these claims are not, in fact, canceled in the most recent Claim Amendments document received August 7, 2006. While it is understood Applicant intended to cancel **Claims 6-9 and 25-74**, for now, they are considered to be withdrawn and will not be considered canceled until the Claim Amendments reflect the cancellation.

Claim Rejections

35 USC § 102(e)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(1) **Claims 1, 3-5, and 10-24** are rejected under 35 U.S.C. 102(e) as being anticipated by WIPO Publication No. WO 2004/050646 A1 (Kenny, et al.), published June 17, 2004, having a priority date of November 29, 2002. Kenny, et al. discloses numerous compounds which anticipate Applicant's Markush language of **Claim 1**. A specific example is found on p. 34, namely Example 5, 5-{4-[2-(methylcarbamoyl)ethyl]phenyl}-1,2,5-thiadiazolidin-3-one 1,1-dioxide.

(2) **Claims 1, 3-5, and 10-24** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2004023974 A1 (Coppola, et al.), published February 5, 2004, having a priority date of April 3, 2002. Coppola, et al. discloses numerous compounds which anticipate Applicant's Markush language of **Claim 1**. A specific example is found on p. 48, namely Example 36, 5-(2,4-diaminophenyl)-1,1-dioxo-1,2,5-thiadiazolidin-3-one.

35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, and 10-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bright, et al., *Journal of Immunological Methods*, “Competitive particle concentration fluorescence immunoassays for measuring anti-diabetic drug levels in mouse plasma”, Vol. 207 (1), pp. 23-31, (1997). At p. 28, Bright et al. discloses Compound 12, which anticipates Applicant’s Markush language of **Claim 1**.

Objections

Claims 6-9 and 25-74 are objected to for containing nonelected subject matter.

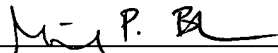
Claim 5 recites a compound of formula (I-A); however, the accompanying table refers to “-T_mQ”, which is a reference to compounds of formula (I). It is assumed this is a typographical error and that Applicant intended “-T_mQ” to simply read “Q”.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is viable through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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